

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. O'CONNOR, FRED A. STUBER,
KIRAN B. CHANDALIA and ADAM G. MALOFSKY

Appeal No. 1997-1787
Application 08/296,628¹

ON BRIEF

Before McKELVEY, Senior Administrative Patent Judge, and SCHAFER and LEE, Administrative Patent Judges.

SCHAFER, Administrative Patent Judge.

DECISION ON APPEAL

Applicants appeal from the final rejection of claims 11-14, and 16-22, all of the claims in the application. The examiner rejected all the claims under 35 U.S.C. § 103 as unpatentable over the combination of U.S. Patent 3,716,535 issued to Markiewitz and U.S. Patent 4,456,658 issued to Kubitza. We have jurisdiction pursuant to 35 U.S.C. § 134. We reverse.

¹ Application for patent filed August 26, 1994. According to appellant, the application is a division of Application 08/065,009 filed May 24, 1993, now Patent No. 5,370,908, granted December 6, 1994.

The subject matter of the invention relates to low volatile organic coating compositions. Such coatings are generally referred to in the art as “low VOC” coatings. Claims 10-14, 16-18 and 20-22 are composition claims. Claim 19 is directed to a process for coating using the composition.

Applicant asserts that all the claims should not stand or fall together because claim 10 is directed to a composition while claim 19 is directed to a process of coating. Brief, p. 4. However, applicants’ brief does not include any separate arguments for patentability directed to claim 19. Indeed, applicant does not separately address any of the claims and treats them all as a single group. Thus, applicants have not met the requirements of 37 CFR § 1.192(c)(7)(1995) with respect to separate consideration of the claims. Accordingly, we select claim 10 as the representative claim for deciding patentability. 37 CFR § 1.192(c)(7).

Claim 10 states (indentation added):

10. A low volatile-organics coating composition having
 - a viscosity as measured by ZAHN cup 2 of less than about 200 seconds and
 - consisting essentially of
 - at least one aliphatic polyisocyanate,
 - a solvent in an amount of between 0% and 45% by weight based upon the amount of said polyisocyanate in said composition, and
 - a trimerization catalyst,
 - said composition being essentially free of any volatile mono- and di-isocyanates.

The examiner relies on the combination of the teachings of Markiewitz and Kubitza. She identifies three differences between the claimed subject matter and the compositions taught by Markiewitz: (1) the use of an aliphatic polyisocyanate (Markiewitz teaches aromatic isocyanates); (2)

the absence of volatile mono- and di-isocyanates and (3) the viscosity shown in the claims. Answer, p. 3.

With respect to the first difference, the examiner finds that Kubitza teaches coating compositions using aliphatic isocyanates. The examiner then concludes that

It would have been obvious to use the specific polyisocyanates of Kubit[z]a in Markiewitz's coating because Kubit[z]a teaches better resistance to chemicals and solvents (col. 1, lines 30-31) when using these polyisocyanates versus those of conventional polyurethanes.

Answer, p. 4.

Applicants point out, however, that the two references describe different catalyst systems to effect curing. Reply Brief, p. 3. Markiewitz uses a trimerization catalyst, which results in a heat curable coating. On the other hand, Kubitza describes the use of a catalyst which results in a moisture-curable coating. There is nothing in the two references which would suggest that the trimerization catalysts used by Markiewitz to cure aromatic isocyanates would be effective catalysts for the aliphatic isocyanates described by Kubitza. Based on the teachings of the two references, we can not conclude that a person having ordinary skill in the art would have a reasonable expectation of success in substituting the aliphatic isocyanates disclosed by Kubitza for the aromatic isocyanates in the trimerization catalyst coating described by Markiewitz. "Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under § 103 requires, inter alia, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). In proceedings before the PTO the examiner has the burden of establishing the prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d

1443, 1444 (Fed. Cir. 1992); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); In re Rhinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). The examiner has the burden to present factual basis supporting the conclusion that a prima facie case exists. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); In re Lunsford, 357 F.2d 385, 392, 148 USPQ 721, 726 (CCPA 1966); In re Freed, 425 F.2d 785, 788, 165 USPQ 570, 572 (CCPA 1970). In failing to demonstrate that the person of ordinary skill in the art would have a reasonable expectation of success in substituting aliphatic isocyanate for aromatic isocyanate, the examiner has not met the burden of establishing a prima facie case of obviousness.

When this application returns to the jurisdiction of the examiner, applicant and the examiner may wish to consider the relevance of U.S. patent 4,864,025.

REVERSED

FRED E. McKELVEY, Senior
Administrative Patent Judge

RICHARD E. SCHAFER
Administrative Patent Judge

JAMESON LEE
Administrative Patent Judge

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